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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/617,433	07/14/2000	Shoji Yasuda	2870-0137P	5348

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03/13/2002

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EXAMINER

CHEA, THORL

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 03/13/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/617,433

Applicant(s)

YASUDA, SHOJI

Examiner

Thorl Chea

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 5-9 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0887701 (EP'701).

A thermally processed image forming material containing a fatty acid silver salt has been known in EP'701. Note especially to page 2, lines 49-52; page 3, line 19-36; page 4, lines 35-page 5, line 2; page 10, lines 43-45; page 12, line 19-line 27; page 16, lines 35-49; page 20, lines 42-46; Tables 1-2 page 29-29, Table 3, page 30-31. The organic silver dispersion was made from behenic acid and stearic acid. The material of EP'701 and that of the present claimed invention contains same fatty acid made with similar process. Accordingly, the invention as claimed lacks novelty. Alternatively, it would have been prima facie obvious to the worker of ordinary skill in the art to use a known process of forming fatty acid silver to provide an invention as claimed. "(E)ven though

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product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process." In re Thorpe 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985).

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP'701 as applied to claims 1, 3, 5-9 above, and further in view of WO97/34196 (WO'196) and EP'433.

The nucleating agent in claim 10 has been known in EP'433 on pages 6-13 and WO'196 on page 5. It would have been obvious to the worker of ordinary skill in the art to improve the image contrast of the material of EP'701 by incorporated therein the nucleating agent taught in WO'196 or EP'433 to provide the invention as claimed.

5. Claim 4 is rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either EP'021433 (EP'433) or WO 97/341196 (WO'196).

The WO'196 on page 37, claim 1 and EP' on page 42, claim 1 disclose a material having composition similar to that of the claimed invention. The material contains an silver salt of aliphatic carboxylic silver salt, a reducing agent and a nucleating agent having formula claimed in the present claimed invention. Note to WO'196 on page 33 formulation A wherein the material contains isoxazole co-developer and silver behenate; and EP'433 on pages 34-36, Example 2 wherein the organic silver salt made from silver

salt made from aliphatic carboxylic acid, and nucleating agent of the claimed invention. The EP'433 and WO'196 may not disclose the process of making the silver salt of aliphatic carboxylic acid at an operation pressure of 1,800 kg/cm² presented in the claimed invention, but this limitation is related to the process of preparing silver salt of aliphatic carboxylic acid which fails to differentiate between the claimed material and that of the prior art of record. "(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process." In re Thorpe 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985). Accordingly, the claimed material is either anticipated or would have been found obvious to the worker of ordinary skill in the art in the absence of showing otherwise.

Response to Arguments

6. Applicant's arguments filed December 31, 2001 have been fully considered but they are not persuasive. The applicants' argument is based on the process of making silver salt of aliphatic carboxylic acid. However, the patentability of the claimed material cannot be determined using the processing steps limitation in view of In re Thorpe 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985) set forth above. Moreover, the argument with respect to the unexpected results is not persuasive since the claims are rejected under both ground of rejection, i.e., 35 USC 102(a) and 35 USC 103. "(E)vidence of secondary considerations, such as unexpected results or commercial

success, is irrelevant to 35 U.S.C 102 rejections and thus cannot overcome a rejection so based. In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973). The applicants fails to show the distinction between the claimed material and that of the applied prior art of record.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea 
March 1, 2002


Thorl Chea
Primary Examiner
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